

## REMARKS

All claims presently stand rejected as either anticipated by or obvious in view of U.S. Patent 5,805,868 to Murphy. For the reasons set forth herein, Applicants respectfully traverse these rejections and request that they be withdrawn.

### ***Fundamental Distinction Applicable to All Claims***

There is at least one fundamental distinction of all claims in the presently pending application, which clearly define these claims over the cited reference to Murphy. Specifically, every independent claims of the present application includes the following element: “leaving a current clear count for the region unchanged.” This claim feature is neither disclosed nor suggested anywhere in the Murphy reference. As a result, all rejections of the presently-pending claims, based upon the teachings of Murphy, are misplaced and should be withdrawn.

Taking claim 1 as an exemplary claim, claim 1 states that “***responsive to a clear command; leaving a current clear count for the region unchanged.***” Thus, Applicants’ claims require the current clear flag to remain unchanged, ***in response to a clear command.*** However, Murphy teaches the direct opposite of this. The Office Action (paragraph 3) cites column 55, lines 31-33 and column 59, lines 4-6 of Murphy as allegedly teaching this claimed feature. This citation to Murphy is misplaced. Beginning at line one of column 55, the Murphy patent describes the “clear” operation of the invention of that patent. As is unambiguously taught at lines 12-15 of column 55, Murphy states that “every time the application issues a clear command, the reference FrameCount is incremented (and allowed to rollover if it exceeds its maximum value), and only the  $i^{\text{th}}$  region is cleared.” This action precedes the comparison action of lines 31-33, which the Office Action referenced, and

cannot be ignored. Further, the teaching of Murphy explicitly states that the FrameCount is incremented “every time the application issues a clear command.” Again, this is completely opposite of what the claims of the present application require.

The abstract of Murphy teaches the same thing, in a more concise fashion. There, Murphy teaches that a clear operation is implemented by using a reference framecounter. A window of interest is divided up into n regions. Significantly, “every time the application issues a clear command, the reference FrameCounter is incremented (and allowed to rollover if it exceeds its maximum value), and only the n<sup>th</sup> region is cleared.” (Abstract, lines 7-10). Therefore, with regard to the Applicants’ claim element of “leaving a current clear count for the region unchanged,” Murphy teaches the direct opposite. Consequently, Murphy neither anticipates nor renders obvious any claim of the presently-pending application.

For at least this fundamental reason, all rejections set forth in the Office Action are misplaced and should be withdrawn. With the withdrawal of these rejections, all claims are in condition for allowance. Should the Examiner issue any ensuing office action (either citing new references or changing the basis for rejection based on Murphy), any such ensuing office action must be made non-final, as any rejection therein would constitute new grounds not necessitated by any amendments made to the claims.

***Independent Claims 1, 8, 27 and 28***

In addition to the fundamental distinction that is applicable to all claims of the presently-pending application, Applicants set forth the following additional discussion and distinctions. The Office Action rejected independent claims 1, 8, 27 and 28 under 35 U.S.C. §102(b) as allegedly anticipated by Murphy (USPN 5,805,868).

### Independent Claim 1

Independent claim 1 recites:

1. A method of performing clear operations in a region having a subregion, comprising:  
*responsive to a clear command:*  
*leaving a current clear count for the region unchanged;*  
writing a predetermined value into each of the pixels of the subregion, but not into the pixels outside the subregion; and  
*writing the current clear count into clear count storage locations corresponding to each of the pixels of the subregion, but not into clear count storage locations corresponding to the pixels outside the subregion.*

(*Emphasis added.*) Applicants respectfully submit that claim 1 patently defines over the cited art for at least the reason that Murphy fails to disclose the features emphasized above.

As discussed above, Murphy fails to disclose (and in fact teaches the opposite) the step of leaving a current clear count for the region unchanged, in response to a clear command. In addition, Murphy fails to teach the “writing of the current clear count into clear count storage locations corresponding to each of the pixels of the subregion.” The Office Action alleges that this is taught by the teaching of “clearing at least some other portions of the respective data values; and not clearing the data values of at least some other pixels” of col. 59, lines 15-17. Applicants disagree. First, the cited teaching of Murphy is discussing a FrameCount value (which is not the same as the clear count of Applicants’ claim). For this reason alone, this application of Murphy against claim 1 is misplaced.

In addition, that teaching of Murphy more completely states:

... and for pixels located in the subregion corresponding to the new framecount value, setting the framecount data equal to the new framecount value, and clearing at least some other portions of the respective data values; and not clearing the data values of at least some other pixels.

Thus, Murphy expressly teaches clearing *some* portions of the data values and *not* clearing the data values of some other pixels. In contrast, claim 1 requires that the

writing of the clear count take place into clear count storage locations corresponding to *each* of the pixels of the subregion.

Although there are other distinctions between claim 1 and Murphy, the differences noted above clearly define claim 1 over Murphy, and the rejection should be withdrawn.

#### **Dependent Claims 2-7**

Claims 2-7 each depend from claim 1 and patently define over Murphy for at least the same reasons as claim 1.

#### **Independent Claim 8**

Claim 8 recites:

8. A method of performing clear operations in a region having a subregion, comprising:
- prior to creation of the subregion*, responding to clear commands for the region according to a fast clear technique;
  - after creation of the subregion and during the life of the subregion*, responding to clear commands for the region by:
    - leaving a current clear count for the region unchanged;*
    - writing a predetermined value into each of the pixels of the subregion, but not into the pixels outside the subregion; and
    - writing the current clear count into clear count storage locations corresponding to each of the pixels of the subregion, but not into clear count storage locations corresponding to the pixels outside the subregion;* and
  - after discontinuance of the subregion*, resuming responding to clear commands for the region according to the fast clear technique.

(*Emphasis added.*) Applicants respectfully submit that claim 8 patently defines over the cited art for at least the reason that Murphy fails to disclose the features emphasized above.

Claim 8 patently defines over Murphy for at least the same reasons that claim 1 defines over Murphy, as claim 8 includes the same defining features of claim 1 (discussed above).

In addition, and as a separate and independent reason for the patentability of claim 8, the “subregion” of the Applicants’ claims is different than the “region” disclosed in Murphy. Murphy discloses subdividing a window into n regions, and only one of the n regions is cleared at a time (with each successive clear command issued by an application, a FrameCount value is increased to cause a next region to be cleared). In the claims of the present application, all pixels in a subregion are cleared in response to a clear command (as opposed to artificially subdividing a region to be cleared, solely to speed the clear process). This is clear from the fact that the clear count for the region of the claims of the present application is unchanged (where Murphy teaches the incrementing of a FrameCount to cover – one by one – all subregions in a region to be clear). Thus, in Murphy, if a window was divided into 16 regions, it would take 16 clear commands to fully clear the window. For at least this additional reason, claim 8 defines over the teachings of Murphy, and the rejection should be withdrawn.

#### **Dependent Claims 9-17**

Claims 9-17 each depend from claim 8 and patently define over Murphy for at least the same reasons as claim 8.

#### **Independent Claims 27-28**

Claims 27 and 28 recite:

27. Computer program code embodied in a machine-readable storage or transmission medium which, when executed on a computer, causes the computer to perform a method of performing clear operations in a region having a subregion, comprising:

**responsive to a clear command:**

**leaving a current clear count for the region unchanged;**

writing a predetermined value into each of the pixels of the subregion, but not into the pixels outside the subregion; and

***writing the current clear count into clear count storage locations corresponding to each of the pixels of the subregion, but not into clear count storage locations corresponding to the pixels outside the subregion.***

28. Computer program code embodied in a machine-readable storage or transmission medium which, when executed on a computer, causes the computer to perform a method of performing clear operations in a region having a subregion, comprising:

prior to creation of the subregion, responding to clear commands for the region according to a fast clear technique;

***after creation of the subregion and during the life of the subregion, responding to clear commands for the region by:***

***leaving a current clear count for the region unchanged;***

writing a predetermined value into each of the pixels of the subregion, but not into the pixels outside the subregion; and

***writing the current clear count into clear count storage locations corresponding to each of the pixels of the subregion, but not into clear count storage locations corresponding to the pixels outside the subregion; and***

***after discontinuance of the subregion,*** resuming responding to clear commands for the region according to the fast clear technique.

*(Emphasis added.)* Applicants respectfully submit that claims 27-28 patently define over the cited art for at least the reason that Murphy fails to disclose the features emphasized above.

Claim 27 closely parallels claim 1, and patently defines over Murphy for at least the same reasons set forth in connection with claim 1. Likewise, claim 28 closely parallels claim 8, and patently defines over Murphy for at least the same reasons set forth in connection with claim 8. Accordingly, Applicants respectfully submit that the rejections of claims 27 and 28 be withdrawn.

***Independent Claims 18 and 29***

The Office Action rejected independent claims 18 and 29 under 35 U.S.C. §103(a) as allegedly unpatentable over Murphy.

Claims 18 and 29 recite:

18. A method of performing clear operations in a region having a subregion, comprising:  
***determining the percentage area of the region occupied by the subregion; and***

***if the percentage area is not higher than a predetermined threshold percentage, responding to clear commands for the region by:***

***leaving a current clear count for the region unchanged;***

writing a predetermined value into each of the pixels of the subregion, but not into the pixels outside the subregion; and

***writing the current clear count into clear count storage locations corresponding to each of the pixels of the subregion, but not into clear count storage locations corresponding to the pixels outside the subregion.***

29. Computer program code embodied in a machine-readable storage or transmission medium which, when executed on a computer, causes the computer to perform a method of performing clear operations in a region having a subregion, comprising:

***determining the percentage area of the region occupied by the subregion; and***

***if the percentage area is not higher than a predetermined threshold percentage, responding to clear commands for the region by:***

***leaving a current clear count for the region unchanged;***

writing a predetermined value into each of the pixels of the subregion, but not into the pixels outside the subregion; and

***writing the current clear count into clear count storage locations corresponding to each of the pixels of the subregion, but not into clear count storage locations corresponding to the pixels outside the subregion.***

(*Emphasis added.*) Applicants respectfully submit that claims 18 and 29 patently define over the cited art for at least the reason that Murphy fails to disclose the features emphasized above.

First, each of these claims patently define over Murphy for at least the same reason as claim 1, as they include the distinguishing features of claim 1, which were discussed above.

As a separate and independent basis for the patentability of these claims, Applicants respectfully submit that the rejection is misplaced, as the Office Action failed to cite any proper motivation to support the extension of Murphy to the features of these claims. In this regard, the rationale set forth in the Office Action is completely subjective on the part of the Examiner. The Office Action alleged only that the combination would have been obvious "because by dividing the region, this region is much smaller than the full window and hence takes less time to clear..." This rationale is misplaced.

In this regard, the prevailing legal standards have been developed to prevent nebulous and vague subjective rationales (such as the conclusion that quality would be enhanced) from supporting rejections under 35 U.S.C. § 103. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, the Applicants note that there must not only be a suggestion to broaden the functional or operational aspects of the cited reference, but that the Federal Circuit also



requires the prior art to suggest the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection, the prior art must properly suggest the desirability of providing a fast clear operation, as claimed by the Applicants. "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

"A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000)) (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)); The Federal Circuit has made it clear "that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999).

Simply stated, the rejection under 35 U.S.C. § 103 set forth by the Examiner fails to satisfy these fundamental legal requisites, and the rejections under 35 U.S.C. § 103 should be withdrawn.

### CONCLUSION

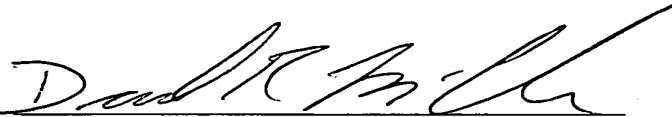
In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the

examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to Hewlett-Packard Company's deposit account No. 08-2025.

Respectfully submitted,

By:



Daniel R. McClure  
Registration No. 38,962

**Thomas, Kayden, Horstemeyer & Risley, LLP**  
100 Galleria Pkwy, NW  
Suite 1750  
Atlanta, GA 30339  
770-933-9500